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REMARKS/ARGUMENTS

Claims 1 through 12 and 14 through 21 are pending. Claims 1 through 12 and 14 through 21 are rejected. Claim 16 is objected to because of informalities. Claims 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kulakowski. Claims 9, 11, 15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski. Claims 1, 2, 7, and 8 are rejected under 35 USC 103(a) as being unpatentable over Joffe in view of Kulakowski. Claims 3 and 6 are rejected under 35 USC 103(a) as being unpatentable over the combination of Joffe and Kulakowski, and further in view of Nagai. Claim 4 is rejected under 35 USC 103(a) as being unpatentable over the combination of Joffe and Kulakowski, and further in view of Shibata. Claim 5 is rejected under 35 USC 103(a) as being unpatentable over the combination of Joffe and Kulakowski (which was improperly identified by the Examiner as Toyoda), and further in view of Rabenko. Claims 10 and 12 are rejected under 35 USC 103(a) as being unpatentable over Kulakowski and further in view of Nagai. Claim 14 is rejected under 35 USC 103(a) as being unpatentable over Kulakowski and further in view of Joffe. Claim 17 is rejected under 35 USC 103(a) as being unpatentable over Kulakowski, and further in view of Rabenko. Claims 19 and 20 are rejected under 35 USC 103(a) as being unpatentable over Kulakowski, and further in view of Nagai.

These objections are respectfully traversed.

Request for reference

The Examiner has requested a reference that teaches the features disclosed in the background of the specification. See, e.g., ITU-T T.38, as disclosed in the PTO-892 accompanying the Office Action mailed May 20, 2004.

Claims Informalities

Amendments have been made to address the noted informalities. Withdrawal of the objection is requested.

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35 U.S.C. 102(a) Rejections

Claims 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Kulakowski. In particular, it is alleged that "connecting a client to a first Internet service provider that does not need to include fax over Internet protocol functionality over a first connection, the client comprises a fax over Internet protocol client driver that is operable to support a fax over Internet protocol session" and "transmitting a fax from the client to the fax machine using a fax over Internet protocol session that is supported by the fax over Internet protocol client driver of the client via the first connection, the second connection, and the third connection" is disclosed at page 14, lines 26-36 of Kulakowski. This rejection is respectfully traversed.

Kulakowski fails to anticipate claims 16 and 18 under 35 U.S.C. 102(b) because it fails to disclose each element of the claimed invention. Page 14, lines 26-36 of Kulakowski describes software modules stored in a memory of an interface device 10 that are used for "sending and receiving email via the Internet." Kulakowski elsewhere describes that the facsimile messages transmitted between fax machines 12 and 24 are first converted into email messages by interfaces 10 and 26, and are then transmitted via email protocol to the other interface, which converts the email back to a facsimile message. As such, Kulakowski at least fails to disclose a client that comprises a fax over Internet protocol client driver or a fax over Internet protocol session. If the Examiner construes the email functionality of interfaces 10 and 26 of Kulakowski to be the "fax over Internet protocol client driver," then network service providers 18 and 32 must therefore need to include the "fax over Internet protocol functionality," else they will be unable to send or receive email. Likewise, construing the transmission of an email from network service providers 18 and 32 as being part of a fax over Internet protocol session again requires network service providers 18 and 32 to include the "fax over Internet protocol functionality," i.e., the ability to send and receive email messages. As such, the construction of "fax over Internet protocol" to be the email protocol of Kulakowski fails to anticipate claim 16, by virtue of the fact that the network service providers 18 and 32 must necessarily include email protocol functionality if they are to be able to transmit emails between interfaces 10 and 26.

In regards to claim 18, in addition to depending from an allowable base claim, Kulakowski fails to disclose an "Internet capable fax machine." Being able to send and receive emails does not make a fax machine Internet capable, because an email server is required to

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allow the fax machine to operate. At a minimum, an "Internet capable fax machine" should be able to send and receive facsimile messages with nothing more than an Internet connection. Without the email server functionality of network service providers 18 and 32, the fax machines 12 and 24 of Kulakowski are unable to send and receive faxes over the Internet. See, e.g., page 15, lines 18-30 ("The device of the present invention also can send faxes via the PSTN. . . . the present invention automatically transmits the data using fax communications standards if email is not possible.") (emphasis added). The construction of "Internet capable" adopted by the Examiner equates "email capable" with "Internet capable." This is clearly incorrect, as anyone who has tried to access email stored on an email server through the Internet where the server is not configured for such Internet access can readily attest -- access to such a server is "email capable" but not "Internet capable."

Withdrawal of the rejections of claims 16 and 18 is respectfully requested.

35 U.S.C. 103(a) Rejections

Kulakowski fails to provide a prima facie basis for the rejection of claims 9, 11, 15 and 21 under 35 U.S.C. 103(a), because it fails to anticipate each element of the claimed invention. In regards to claim 9, Kulakowski fails to disclose "the personal computer client maintains a fax over Internet protocol session with the fax machine using the fax over Internet protocol client driver, and the personal computer client is not the first Internet service provider." The email protocols disclosed by Kulakowski do not support a session between a personal computer client and a remote fax machine. Emails are transmitted in three sessions -- from the sender to the sender's email server, from the sender's email server to the recipient's email server, and from the recipient's email server to the recipient. Each of these three sessions are completely independent -- one does not begin until the other has been completed. During the first session, the recipient's email server and the recipient can both be unavailable. During the second session, the sender and recipient can be unavailable. During the third session, the sender and the sender's email server can be unavailable. As such, there is no way to "maintain" a fax over Internet protocol session between the personal computer client and the fax machine using the "fax over Internet protocol client driver" as construed by the Examiner (i.e., email.). Claims 11, 15 and 21 are allowable at least for the reason that they each depend from an allowable base claim and add limitations not found in the prior art.

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Claims 1, 2, 7, and 8 are rejected under 35 USC 103(a) as being unpatentable over Joffe in view of Kulakowski. Joffe in view of Kulakowski fail to provide a prima facie basis for the rejection of claims 1, 2, 7 and 8 because they fail to disclose each element of the claimed invention.

The Examiner admits that Joffe does not teach that the T38 protocol driver is included in the client system, but alleges that it would have been obvious to combine the email functionality of Kulakowski with Joffe "to meet the requirements required by the Internet service provider from the client device." Further, even though the T38 protocol driver is not included in the client system, the Examiner nonetheless alleges that the client system "maintains the fax over Internet protocol session with the fax machine using the T38 protocol client driver." As such, the Examiner's position is untenable – how can a client that does not include a T38 protocol driver maintain the fax over Internet protocol session with the fax machine using a T38 protocol driver? Clearly, it cannot. Merely disclosing a T38 driver at an ISP fails to disclose how to implement that T38 driver at the client, nor how the client can maintain the fax over Internet protocol session using the T38 driver that it never had.

Furthermore, providing the client with a T38 protocol client driver is not required if the Internet service provider supports T38 protocol sessions. The motivation for providing the client with the T38 protocol driver is not to meet requirements of the ISP, but rather to allow the client to initiate a T38 protocol session while the client is connected to the ISP without disconnecting from the ISP. Combining Joffe and Kulakowski fails to provide the required motivation, because both Joffe and Kulakowski allow a user to send faxes to a remote fax machine. Neither Joffe nor Kulakowski discuss the motivation for providing the client with the T38 protocol driver – they are only concerned with allowing a user to send faxes over an IP network. It is only by the use of impermissible hindsight, through the identification of problems that are unrecognized by either of Joffe or Kulakowski, that the motivation to combine is provided, not to mention that the solution to those unrecognized problems is not even provided by the combination.

Claims 2, 7 and 8 are allowable at least for the reasons that they allow from an allowable base claim and add limitations not present in the prior art.

Claims 3 and 6 are rejected under 35 USC 103(a) as being unpatentable over the combination of Joffe and Kulakowski, and further in view of Nagai. For the reasons discussed above, Joffe and Kulakowski fail to disclose each element of the claimed invention, and there is

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no motivation to combine them either. The addition of Nagai does not address any of these shortcomings – even though simultaneous communications could be performed over an IP session, Nagai fails to even address T38, much less the limitation that using T38 through an ISP requires a current IP session to be stopped and a new T38 session to be initiated. Furthermore, the Examiner asserts that Nagai discloses "that at least one additional Internet protocol session can be operated, such as a web browser, during the facsimile transmission," but CTI server 300 includes separate PBX and LAN interfaces, such that there is no relevance whatsoever of Nagai to the present invention, in which a single interface is used to maintain two or more protocol sessions.

Claim 4 is rejected under 35 USC 103(a) as being unpatentable over the combination of Joffe and Kulakowski, and further in view of Shibata. For the reasons discussed above, Joffe and Kulakowski fail to disclose each element of the claimed invention, and there is no motivation to combine them either. The addition of Shibata does not address any of these shortcomings.

Claim 5 is rejected under 35 USC 103(a) as being unpatentable over the combination of Joffe and Kulakowski (which the Examiner improperly identified as Toyoda), and further in view of Rabenko. For the reasons discussed above, Joffe and Kulakowski fail to disclose each element of the claimed invention, and there is no motivation to combine them either. The addition of Rabenko does not address any of these shortcomings.

Claims 10 and 12 are rejected under 35 USC 103(a) as being unpatentable over Kulakowski and further in view of Nagai. The Examiner improperly states that arguments analogous to claim 6 are applicable to claim 10. Claim 10 states that the personal computer client maintains at least one additional Internet protocol session over the connection with the first Internet service provider without switching between modes – claim 6 does not include any limitation regarding modes, and the arguments regarding claim 6 are therefore inapplicable to claim 10. Furthermore, the email facsimile client of Kulakowski only has a single mode – email. It is incapable of supporting multiple modes. As previously discussed, Nagai supports multiple modes through multiple connections.

Claim 14 is rejected under 35 USC 103(a) as being unpatentable over Kulakowski and further in view of Joffe. As discussed, there is simply no motivation to combine Kulakowski, which uses an email functionality to send faxes, with Joffe, which uses an ISP-hosted T38

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protocol to send faxes. Even if there was, there is no suggestion on why it would be desirable to move the T38 protocol from the ISP to each of the separate clients, and how to support the T38 protocol session from the client.

Claim 17 is rejected under 35 USC 103(a) as being unpatentable over Kulakowski, and further in view of Rabenko. For the reasons discussed above, Kulakowski in view of Rabenko fails to provide a prima facie basis for the rejection of claim 17 because they fail to disclose each element of the claimed invention.

Claims 19 and 20 are rejected under 35 USC 103(a) as being unpatentable over Kulakowski, and further in view of Nagai. For the reasons discussed above, Kulakowski in view of Nagai fails to provide a prima facie basis for the rejection of claims 19 and 20 because they fail to disclose each element of the claimed invention.

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CONCLUSION

In view of the foregoing remarks and for various other reasons readily apparent, Applicant submits that all of the claims now present are allowable, and withdrawal of the rejection and a Notice of Allowance are courteously solicited.

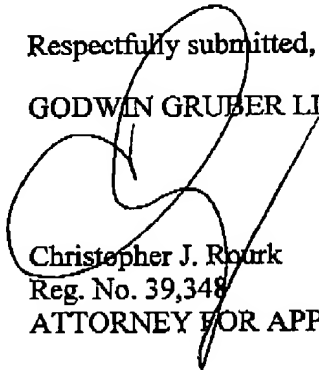
If any impediment to the allowance of the claims remains after consideration of this amendment, a telephone interview with the Examiner is hereby requested by the undersigned at (214) 939-8657 so that such issues may be resolved as expeditiously as possible.

No fee is believed to be due at this time. If any applicable fee or refund has been overlooked, the Commissioner is hereby authorized to charge any fee or credit any refund to the deposit account of Godwin Gruber LLP, No. 500530.

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Respectfully submitted,

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